

REMARKS

Support for amendment of claim 66 is found in claim 87. No new subject matter has been added as a result of these amendments.

The amendments to the specification correct a clear typographical error and further clarify the relationship between this application and related applications. Claim 86 is cancelled without prejudice to their further prosecution in any subsequent continuation application. Upon entry of this amendment, claims 66-100 are present, and claims 66-85 and 88-100 are active, in the application.

Applicants acknowledge the examiner's finding of allowable subject matter of claims 71, 73, 74, 87-90, 94-98, and 100. The objection of these claims as being dependent upon a rejected base claim (66) has been obviated through appropriate amendment.

The objection to the abstract has been obviated by appropriate amendment.

The amendment of the specification at paragraph [0001] has not been entered because it is alleged that the amendment is a new claim of priority to previous applications. Applicants traverse this objection because the amendment merely corrects a clear typographical error in the identification of related applications, which does not constitute a new claim of priority. Paragraph [0001] uniquely identified application Serial No. 09/358,504 by title, filing date, and by stating it is a continuation-in-part of application Serial No. 09/036,706. Applicants submit that the amendment of paragraph [0001] with regard to the application designated originally as "Serial No. 09/358,505" merely corrects a clear typographical error contained in the application as filed.

The amendment of paragraph [0001] has been objected to on the basis that U.S. Provisional Application No. 60/252,861 does not also claim priority to U.S. Application Serial Nos. 09/358,504 and 09/036,706. However, Applicants note that a provisional application is not entitled to the right of priority of any other application under section 119 or to the benefit of an earlier filing date in the United States under section 120 or 121. See MPEP § 601. Applicants are not claiming priority of the two non-provisional applications through the provisional application. Rather, a proper claim of priority can be made to multiple independent applications provided that the applications are co-pending with the application for which the benefit of priority is being sought. See MPEP § 201.11.

Applicants are making a proper claim of priority to all co-pending applications: (1) U.S. Provisional Application No. 60/252,861; (2) U.S. Application No. 09/358,504; and (3) U.S. Application No. 09/036,706. Applicants respectfully request that this objection be withdrawn and the amendment of paragraph [0001] be entered.

The rejections of claims 66, 67, 75, 76, 78, 79, 82, 86, 91, 92, 93, and 99 under 35 U.S.C. § 102(b) as being anticipated by Lee et al. have been obviated incorporating claim 87 into claim 66.

The rejections of claims 66, 68-70, and 72 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. have been obviated by incorporating claim 87 into claim 66.

The rejections of claims 66, 67, 69, 70, 75-77, 82, and 83 under either the doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 6, 9, and 12 of U.S. Patent No. 6,335,201 or 35 U.S.C. § 102(f) have been obviated by incorporating claim 87 into claim 66.

The rejections of claims 68-70, 75, 76, and 82 under the doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5, 7, and 17 of U.S. Patent No. 6,740,497 have been obviated by incorporating claim 87 into claim 66.

The rejections of claims 66, 67, and 80-82 under either the doctrine of obviousness-type double patenting as being unpatentable over claims 48, 50, 51, 59, and 70 of co-pending U.S. Patent Application Serial No. 09/945,396 or 35 U.S.C. § 102(f) have been obviated by incorporating claim 87 into claim 66.

Applicants respectfully submit that the application is in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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Case No. CAL01-005-US
First Named Inventor: Nancy Allbritton
Serial No. 09/990,413
Filing Date: November 21, 2001
For: METHOD TO MEASURE THE ACTIVATION STATE OF
SIGNALING PATHWAYS IN CELLS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Transmitted herewith is:

Credit Card Payment Form
Transmittal and Certificate of Mailing Under 37 CFR 1.8 (in duplicate)
Petition and Fee for Extension of Time (37 CFR 1.136(a)) (three month)
Amendment and Request for Reconsideration

Date of Mailing **Paul E. Rauch, Ph.D., Registration No. 38,591**
March 17, 2006